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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/623,443

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Karen Luke

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4704

28857

7590

10/09/2007

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EXAMINER

FIGUEROA, JOHN J

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

10/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/623,443	Applicant(s) LUKE ET AL.	
	Examiner John J. Figueroa	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 138 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33, 40, 43-47, 49, 53-55, 58, 61, 62, 65, 106, 110, 113-121, 125, 128-132 and 134-137 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/6/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 33,40,43-47,49,53-55,58,61,62,65,106,110,113-121,125,128-132 and 134-138.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. Receipt is acknowledged of a request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e) and a submission (amendment), filed on June 25, 2007. The request has been deemed proper and this application has been hereby examined in view of said amendment.

Response to RCE Amendment

2. The 35 U.S.C. 102(b) rejection of claims 33, 43, 44, 47, 55 and 135 as anticipated by United States Patent Number (USPN) 4,372,876 to Kulprathipanjan et al. (hereinafter 'Kulprathipanjan') previously made of record in item 2 on page 2 of the Final Office Action of May 25, 2007 (hereinafter 'FOA') has been withdrawn in view of Applicant's amendment to the claims in the response filed to FOA filed with RCE on July 25, 2007 (hereinafter 'Response').

3. The 35 U.S.C. 102(b) rejection of claims 33, 40-45, 47, 49, 55, 58, 61, 65, 106, 110, 113-116, 120, 135 and 136 as anticipated by USPN 4,986,989 to Sirosita et al. (hereinafter 'Sirosita') has been maintained for reasons previously made of record in item 3 on page 3 of FOA.

4. The 35 U.S.C. 102(e) rejection of claims 33, 41, 43, 44, 53-55 and 58 as anticipated by U.S. Pat. Appl. Pub. Number 2002/0117090 to Ku et al.

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(hereinafter 'Ku') previously made of record in item 4 on page 3 of FOA has been withdrawn in view of Applicant's amendment to the claims in Response.

5. The 35 U.S.C. 103(a) rejection of claims 33, 40-47, 49, 53-55, 58, 61, 62, 65, 106, 110, 113-121, 125, 128-132 and 134-137 as unpatentable over USPN 4,548,734 to Chaux et al. (hereinafter 'Chaux') has been maintained for reasons previously made of record in item 6 on page 4 of FOA.

6. The 35 U.S.C. 103(a) rejections of record in items 7 and 8 of FOA as unpatentable over Ku has been withdrawn in view of Applicant's amendment to the claims in Response.

7. The outstanding obviousness type double patenting rejections have been maintained for reasons previously made of record in items 10-12 in Response.

Election/Restrictions

8. Newly submitted claim 138 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the new claim is drawn to a "system" (method) for treating a wellbore comprising a first fluid that is incompatible with a second fluid and involving method steps, such as "preventing contact" between said first and second fluids. Moreover, the composition recited within the body of this method claim is not limited to the weight percentage properties of the amended claims.

Furthermore, this claim drawn to a "system" is not supported by the present specification and, therefore, raises issues of new matter.

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Because Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 138 has been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

The 35 U.S.C. 102 Rejection over Kulprathipanja (item 2 of FOA)

9. Applicant's arguments with respect to the captioned 35 U.S.C. 102 rejection of as unpatentable over Dahanayake in view of DiLullo have been considered but deemed moot due to the withdrawal of this rejection in view of Applicant's amendment to the claims in Response.

The 35 U.S.C. 102(b) Rejection over Sirosita (item 3 of FOA)

10. Applicant's arguments with respect to the captioned 35 U.S.C. 102(b) rejection of claims 33, 40-45, 47, 49, 55, 58, 61, 65, 106, 110, 113-116, 120, 135 and 136 as anticipated by Sirosita have been fully considered but deemed unpersuasive.

Applicant's principal argument distinguishing Sirosita from the present claims is that Sirosita does not disclose the new range limitation for the zeolite component of the composition recited in the instant claims, as amended. This argument is incorrect. Sirosita clearly discloses the zeolite component of the composition to be present, preferably, in a range of 1 to 99% of the composition.

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(Col. 3, lines 44-46) Applicant's reliance on examples disclosed in *Sirosita* is misguided because "[d]isclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments." *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. See MPEP 2123

Thus, the instant claims, as amended, remain anticipated by *Sirosita*.

The 35 U.S.C. 102 and 103 Rejections over Ku (items 4, 7 and 8 of FOA)

11. Applicant's arguments with respect to the captioned 35 U.S.C. 102 rejection of as anticipated by *Ku* have been considered but deemed moot due to the withdrawal of this rejection in view of Applicant's amendment to the claims in Response.

The 35 U.S.C. 103(a) Rejection over Chaux (item 6 of FOA)

12. Applicant's arguments with respect to the captioned 35 U.S.C. 103(a) rejection of claims 33, 40-47, 49, 53-55, 58, 61, 62, 65, 106, 110, 113-121, 125, 128-132 and 134-137 as unpatentable over *Chaux* have been fully considered but deemed unpersuasive.

Similar to the discussion regarding *Sirosita*, *supra*, Applicant's principal argument traversing this rejection is that *Chaux* does not disclose the range

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limitation for the zeolite component of the composition that is recited in the amended claims (about 60 to 70 percent of dry materials of the composition).

This argument is incorrect. Examiner respectfully draws Applicant's attention to col. 11, lines 37-42 in Chaux. Chaux discloses a formulation wherein the zeolite component of the composition can be present in a range of 7 to 40% of the composition; surfactant in a range 0 to 10%; and water in a range of 15 to 37%. Accordingly, the zeolite can be present in, e.g., 40%, the surfactant 1% and water 37%. Thus, the zeolite in this example in Chaux can be present in $40/(100-38)$ of the dry materials, which is about 65%.

Thus, the instant claims, as amended, remain anticipated by Chaux.

The Obviousness-Type Double Rejections (items 10-12 of FOA)

13. Applicant's arguments with respect to the captioned double patenting rejections have been fully considered but deemed unpersuasive.

Applicant's arguments concerning the preamble of the instant claims reciting the composition drawn to a wellbore spacer fluid patentably distinguishing the present claims from those in the cited patents of the captioned patent (drawn to, e.g., a drilling fluid) are incorrect. A recitation of an intended future use of a claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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Thus, the claims remain rejected under obviousness-type double patenting.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references, although relevant, were deemed cumulative.

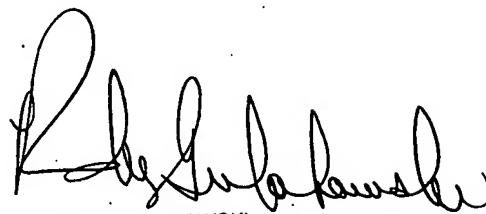
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571) 272-8916. The examiner can normally be reached on Mon-Thurs 8:00-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJF/RAG



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